REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

With the exception of claims 2, 15, 28, 37, 54 and 67, which have been canceled, claims 1 through 80 are pending. All pending claims have been rejected.

CLAIMREJECTIONS

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected all the pending claims under 35 U.S.C. § 103(a), as being unpatentable over U.S. Pat. No. 5,881,287 to Mast (the "Mast reference") in view of U.S. Pat. No. 5,986,676 to Dwin et al (the "Dwin reference"). The Examiner, however, has failed to establish a prima facie case of obviousness, and Applicant must respectfully traverse these rejections for the following reasons:

Applicants respectfully traverse all the 103 rejection under the above listed combination of separate and unrelated references on the grounds: (1) that the Examiner hasn't shown any motivation to combine any of the cited references, and (2) even if it were proper to combine the cited references, the combination of the references does not teach or suggest all the claimed limitations of independent claims 1, 14, 27, 36, 45, 50, 53 and 66.

As the Examiner should well know, the basic rule of law with regards to obviousness type rejections is that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (the use of hindsight as

motivation is not allowable); second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. ***The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.***

The Examiner appears to have taken the position that there was some motivation to combine two separate unrelated references directed to two separate unrelated inventions. While only one of two cited references is directed to copyright protection (the Mast reference), the subject of the pending claims, and the other reference is only generally related to video display technology (the Dwin reference), the Examiner vaguely asserted that there is some motivation to combine the references because "One skilled in the art would haven been motivated to do so because modifying the significant pixels provides control and identification of data locations that need to be protected before displaying on the screen...". Applicant would like to point out that:

(1) All the claims of the present invention are directed to protecting against memory being copied from a video memory;

(2) The Dwin reference teaches using a least significant bit of some data as part of a method and system for protecting against memory being written to a screen (i.e. video memory);

(3) Running a patent search for U.S. patents generally related to "video memory" resulted in 4,519 patents being identified;

(4) The term "least significant bit" appears in 17,266 U.S. patents; and

(5) The terms "video memory" and "least significant bit" appear together in 304 U.S. patents.

In light of the fact there are so many patents generally related to the subject matter claimed in the present application, Applicant does not understand how the Examiner has selected as a secondary reference the Dwin reference, which reference teaches away from at

least one step required by the present claims (i.e. writing to the video memory). Applicant, therefore, asserts that the Examiner has used ***impermissible hindsight*** to try to reconstruct the Applicant's invention by using the Applicant's structure as a template and selecting elements from the references to fill the gaps (see In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Applicant notes that for the purpose of considering whether a suggested combination may be used to establish implicit teaching, motivation, or suggestion, the references to be combined must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination.

> "[T]he test for establishing an implicit teaching, motivation, or suggestion is what the combination of these two statements of Evans would have suggested to those of ordinary skill in the art, the two statements cannot be viewed in the abstract...Rather, they must be considered in the context of the teaching of the entire reference." *In re Kotzab*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000)

Applicant respectfully asserts that an adequate consideration of the prior art cited by the Examiner as a whole, could not have been used to establish sufficient implicit teaching, motivation, or suggestion of the present invention at least in part because of the unrelated nature of the secondary reference. Therefore, Applicant asserts that the Examiner's 103 rejections were improper and requests their withdrawal.

Additionally, whereas each of the independent claims of the present application recites the modification of "least significant bits" of a given pixel prior to transferring the pixel to video memory, the Dwin reference refers to "least significant bit" only once, in an unrelated context:

> FIG. 4A is the Lock-In Protection means 54 as referenced in FIG. 2B. Conductor 62 provides access for the memory data bus to be captured by the Protect Data Holding Reg. Means 80. The memory sequencer means 50 provides the necessary controls which instruct Protect Data Holding Reg. means 80, when to capture the data on conductor 62. Once an entire video line of data is captured by means 80, the memory sequencer then loads the entire contents of means 80 into the protect data shift reg. means 81. At this point, the 160-bit wide shift register means 81 is ready to shift

forward through the lock data. For each memory cycle that writes video to the frame buffer, performed by the memory sequencer means 50, the protect data shift reg. means 81 is shifted. This is done via the control signal "memory cycle lock shift control", which also originates from the memory sequencer. Because the lock buffer is a contiguous array of pixels that has a correspondence to the pixels of the frame buffer, where the uppermost or leftmost screen pixel is protected by the least significant bit of the data word at the address pointed to by the first address of the lock buffer. Consequently, the lowermost and the rightmost screen pixel is protected by the most significant bit of the data word that is pointed to by the last address of the lock buffer. Because the video window can be positioned anywhere on the screen, the lock protect bit which protects the leftmost pixels of the video window can be positioned anywhere within the memory data word. This position for the entire set of leftmost pixels also can vary. The 64:1 multiplexor means 82 provides the mechanism to properly align the lock data within the protect data shift reg. means 81. The horizontal alignment conductor 90 is a 6-bit value selecting 1 of the possible 64 alignments for the leftmost pixels of the video window found in the memory data word. (Description of Fig. 4A – Dwin reference)

Meaning: that the Dwin reference discusses the use of a single bit (e.g. list significant bit) to identify which segment of a screen is "protected" and should be written to.

Thus, not only is there no motivation to combine the references, but even if it were proper to combine the references their combination would not teach all the limitations of each of the independent claims. Even if the Examiner had shown sufficient motivation to combine the teachings of the Dwin reference with the Mast reference, the specific limitation of modifying "least significant bits" of a pixel prior to writing the pixel to video memory is neither taught nor suggested in either of the references.

Therefore, Applicant asserts that the Dwin reference used by the Examiner to support his obviousness rejection may be not be properly combined with the teachings of the Mast reference to show all the limitations of the independent claims. Even if the combination of all the references was appropriate, the two references combined still fail to teach or suggest all the limitation of claims 1, 14, 27, 36, 45, 50, 53 and 66.

Thus, Applicant respectfully requests withdrawal of the Examiner's rejections of claims 1, 14, 27, 36, 45, 50, 53 and 66. All the pending dependent claims are considered to be allowable by virtue of their dependence on allowable independent claims. In view of the foregoing remarks, all pending claims are considered to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3400.

Respectfully submitted,

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